

REMARKS:

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1, 3-4, 7-8, and 10-13 and 21 have been amended. Thus, claims 1-13 and 15-25 are currently pending in the application and subject to examination.

In the Office Action mailed March 15, 2006, the Examiner rejected claim 1-11 and 21-25 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,509,074 to Choudhury ("Choudhury"); claims 13, 14, and 17-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,089,956 to MacPhail ("MacPhail"); claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Choudhury in view of U.S. Patent No. 4,985,697 to Boulton ("Boulton"); claim 15 under 35 U.S.C. § 103(a) as being unpatentable over MacPhail in view of Boulton; and claim 16 under 35 U.S.C. § 103(a) as being unpatentable over MacPhail in view of U.S. Patent No. 4,644,470 to Feigenbaum ("Feigenbaum"). It is noted that claims 1, 3-4, 7-8, and 10-13 and 21 have been amended. To the extent that the rejections still apply to the claims currently pending, the Applicant traverses the rejections, as follows.

Applicant's invention as now set forth in claim 1 is directed to a method of communicating between components of a home subsystem comprising a home library for receiving and storing electronic books, the electronic books comprising data text and a unique key associated therewith, and a portable, electronic viewer for processing and displaying the electronic books, said portable electronic viewer having a unique key associated therewith, the method including in the library, comparing a unique key

associated with data text of an electronic book to a corresponding unique key identifying the electronic viewer.

This system involves electronic books that include not only text but also a unique key associated therewith. This allows electronic books to be sent only to authorized electronic viewers. This method does not require a person to input an identification, when a book is requested, the library automatically compares the unique key of the electronic viewer to a corresponding unique key associated with the data text and either sends the book with a matching unique key or does not send a book because the unique key associated with the book does not match that of the unique key of the electronic viewer to which the book would be sent.

Choudhury teaches a method of protecting electronically published documents including compressing and encrypting the documents, which will be decrypted at a display device or printer. However, in Choudhury, when a user wants to view or print a document, he must make a request for the document via the network by inputting a unique identification such as a credit card number or other valuable number. In Choudhury, the server authenticates the user's request and identification and sends a copy. The electronic text itself does not have an identification number associated with it and neither does the electronic viewer have an associated unique identifier. (See Choudhury at column 4, lines 13-18).

Choudhury relies on the security of an individual not wanting to share an important number in order to prevent unauthorized distribution of electronic documents. In contrast, the present invention, as claimed in claim 1, will only allow electronic books to be sent to authorized hardware (electronic viewer), where a unique key associated

with the electronic viewer matches a unique key which is a part of the electronic book. The present invention provides a more secure method of communicating electronic books.

Thus, the Applicant submits that Choudhury does not describe or suggest at least the feature of a home library for receiving and storing electronic books, the electronic books comprising data text and a unique key associated therewith, as claimed in amended claim 1.

In addition, the Applicants submit that Choudhury does not disclose or suggest a portable electronic viewer for processing and displaying the electronic books, said portable electronic viewer having a unique key associated therewith, as claimed in amended claim 1.

Further, the Applicants submit that Choudhury does not disclose or suggest comparing the unique key associated with data text of an electronic book to the unique key identifying the electronic viewer, as claimed in amended claim 1.

For at least these reasons, the Applicants submit that claim 1 is allowable over the cited art. As claim 1 is allowable, the Applicant submits that claims 2-12, which depend from allowable claim 1, are likewise allowable.

Applicant's invention as set forth in claim 13 is directed toward a method for processing text data for an electronic book home system comprising a library and viewer, the method including communicating the purchase of an electronic book, attaching a unique packet identifier that matches a library identifier associated with the purchaser's library to a packet of text data, and after the unique packet identifier is attached, receiving a packet of text data at the library.

This aspect of the invention protects the sale and transmission of electronic books, by only allowing the storage of electronic books in the electronic library of a purchaser.

MacPhail teaches a method of distributing multiple documents in an information processing system whereby the documents maintain a certain relationship, including a server library which creates a document profile for storing and retrieving documents electronically.

However, the Applicant submits that MacPhail does not disclose or suggest the feature of communicating the purchase of an electronic book, as claimed in amended claim 13. In addition, MacPhail does not disclose or suggest attaching a unique packet identifier that matches the purchaser's library to a packet of text data, and after the unique packet identifier is attached, receiving a packet of text data at the library, as claimed in amended claim 13.

MacPhail does not teach the purchase of electronic books at all. MacPhail does not disclose or suggest attaching a unique packet identifier that matches the purchaser's library to a packet of text data. As MacPhail does not disclose or suggest attaching a unique packet identifier to the text data, MacPhail does not teach the timing of this attachment, whereas claim 13 claims attaching this unique packet identifier before it reaches the library.

For at least these reasons, the Applicant submits that claim 13 is allowable over the cited art. As claim 13 is allowable, the Applicant submits that claims 15-20, which depend from allowable claim 13, are likewise allowable.

Applicant's invention as now set forth in claim 21 is directed toward a method for processing data text for electronic books in a home system comprising a library and a viewer, the method including sending a packet of text data, inserted in a video signal, from a remote operations center to the library.

As discussed above, Choudhury teaches a method of protecting electronically published documents by compressing and encrypting the documents which will be decrypted at a display or printer.

However, the Applicant submits that Choudhury does not describe or suggest at least the limitation of sending a packet of data text, inserted in a video signal, from a remote operations center to the library, as claimed in amended claim 21.

For at least this reason, the Applicant submits that claim 21 is allowable over the cited art. As claim 21 is allowable, the Applicant submits that claims 22-25, which depend from allowable claim 21, are likewise allowable.

Furthermore, the Applicant submits that Boulton does not cure the deficiency in Choudhury and MacPhail. The Applicant further submits that Feigenbaum does not cure the deficiency in MacPhail.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a

showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at pages 13 and 14. This is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may

be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, with reference to Attorney Docket No. 026880-00017.

Respectfully submitted,

Arent Fox PLLC

A handwritten signature in black ink, appearing to read 'Charles M. Marmelstein', written over a horizontal line.

Charles M. Marmelstein
Attorney for Applicants
Registration No. 25,895

Customer No. 004372
1050 Connecticut Ave., N.W.
Suite 400
Washington, D.C. 20036-5339
Telephone No. (202) 857-6008
Facsimile No. (202) 638-4810